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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,096	12/27/2004	Philippe Msika	065691-0381	9007
22428 7590 09/14/2007 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER WESTERBERG, NISSA M	
			ART UNIT 1609	PAPER NUMBER
			MAIL DATE 09/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/519,096

Applicant(s)

MSIKA ET AL.

Examiner

Nissa M. Westerberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20 - 33 is/are pending in the application.
- 4a) Of the above claim(s) 27 - 30, 32 - 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20 - 26, 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2 sheets.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group I with a formulation comprising isoflavone in a glycone or glycosylated form; extract of *Sophora japonica*; extract of *Centella asiatica*; and extract of *Enteromorpha compressa* in the reply filed on August 20, 2007 is acknowledged. The traversal is on the ground(s) that the evidence and explanation fail to establish the lack of novelty of the invention. This is not found persuasive because Applicant fails to point out how the methods of Gorbach et al. cited in the requirement for restriction/election mailed July 18, 2007 do not apply to instant application.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112 2nd Paragraph

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 20 – 26 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. While the terms “slimming” and “fighting localized excess weight” are defined on page 7 of the specification, the terms “refining

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the silhouette”, “accelerating the removal of excesses”, “better defining the contour of the body”, and “resculpturing the silhouette” are not defined.

It is unclear what applicant means by the phrase “isoflavones in a glycone or glycosylated form.” Given the aglycone structures exemplified on p 5 of the specification, the term “glycone” is interpreted to mean the sugar portion of the molecule. Therefore, a glycone form of an isoflavone appears to be indistinguishable from the glycosylated form of an isoflavone.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 20 – 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Director General of Shikoku National (EP 0 829 261 A2).

'261 teaches compositions comprising isoflavones such as genistein, genistin (genistein 7-glucoside), daidzein or daidzin (daidzein-7-O- β -glucopyranoside) (p 2, ln 26 – 27). While these compounds may come from soy (p 2, ln 26), the source of the compound doesn't alter the chemical structure. The composition has the ability to degrade fat and exhibit a weight-reducing effect that may be used for percutaneous (application onto skins) that may be useful in the field of cosmetics (p 2, ln 55 – 57).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Director General of Shikoku National (EP 0 829 261 A2) in view of Di Pierro (PGPub US 2004/0151786 A1) and Mazur et al. (Nutritional Biochemistry, p 193 – 200 (1998)).

As discussed above, '261 discloses compositions of isoflavones for fat degradation that may be applied to the skin. '261 does not disclose extracts of *Sophora japonica* or an extract of *Centella asiatica*.

Di Pierro teaches pharmaceutical and/or cosmetic compositions for the treatment of localized adiposities and cellulite to drastically reduce cutaneous fat deposits ([0004]). These compositions contain a complex of *Centella asiatica* triterpenes with phospholipids as one of the components ([0009]). Di Pierro does not teach the use of *Sophora japonica* extract.

Mazur et al. teaches that *Sophora japonica* extract contains the isoflavones daidzein and genistein (p 198, table 1, last line). Mazur et al. does not teach the use of

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isoflavones for the purposed of weight loss and slimming nor does it disclose extracts of *Centelle asiatica*.

Given the teaching of '261 as to the efficacy of isoflavones for the purposes of fat degradation, the source of the isoflavones is irrelevant and therefore it is not inventive to add extract of *Sophora japonica* to the composition as the source of the isoflavones.

"It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980)" **MPEP 2144.06**.

Given the teachings of '261 in view of Mazur et al. and Di Pierro as to compositions comprising isoflavones that may come from *Sophora japonica* and *Centella asiatica* that are useful for the reduction of fat, it would have been obvious to one ordinary skill in the art to combine the elements into one composition with a reasonable expectation of success.

Conclusion


Claims 20 – 26 and 31 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nissa M. Westerberg whose telephone number is (571) 270-3532. The examiner can normally be reached on M - F, 7:30 a.m. - 5 p.m. ET. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571) 272-0718 or Cecilia Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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NMW


Cecilia J. Tsang
Att. to: Deputy Patent Examiner
Examination